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1754

Docket No.: 208553US0

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TC 1700COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

ATTORNEYS AT LAW

NORMAN F. OBLON
(703) 413-3000
NOBLON@OBLON.COMVINCENT K. SHIER, Ph.D.
REGISTERED PATENT AGENT
(703) 413-3000
VSHIER@OBLON.COM

RE: Application Serial No.: 09/940,438
Applicants: Juergen SCHUBERT, et al.
Filing Date: August 29, 2001
For: DOPED PRECIPITATED SILICA
Group Art Unit: 1754
Examiner: NGUYEN, N.Y.M.

SIR:

Attached hereto for filing are the following papers:

Response to Restriction Requirement (3 pp.)

Our check in the amount of -0- is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Norman F. Oblon

Registration No. 24,618

Customer Number

22850(703) 413-3000 (phone)
(703) 413-2220 (fax)Vince K. Shier Ph.D.
Registration No. 50,552RECEIVED
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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: :
Juergen SCHUBERT, et al. : GROUP ART UNIT: 1754
SERIAL NO.: 09/940,438 :
FILED: AUGUST 29, 2001 : EXAMINER: NGUYEN, N.Y.M.
FOR: DOPED PRECIPITATED SILICA

RESPONSE TO RESTRICTION REQUIREMENT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VA 22312-1450

SIR:

Responsive to the Official Action dated October 6, 2003, Applicants elect, with traverse, Group I, Claims 1-9, for further prosecution.

REMARKS

The Office has required restriction in the present application as follows:

- Group I: Claims 1-9, drawn to an aluminum-doped precipitated silica;
- Group II: Claims 10-14, drawn to a process for preparing aluminum-doped precipitated silica;
- Group III: Claims 15, 20, drawn to a coating;
- Group VI: Claim 16, drawn to a paper;
- Group V: Claim 17, drawn to a plastic film;
- Group VI: Claim 18, drawn to a fabric screen; and
- Group VII: Claim 19, drawn to a flattening agent.

Applicants elect, with traverse, Group I, Claims 1-9.

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Applicants note that claims of Group III-VII are directly dependent from the claims of Group I, as such these groups are not separable.

In regard to Groups I and II, the Office has characterized the relationship between these two groups as "process of making and product made." Citing MPEP §806.05(f), the Office suggests the product as claimed can be made by another and materially different process such as "premixing the sodium silicate and the aluminum salt before step a)". However, there is no evidence of record to show that the claimed products could be made as the Office has alleged. If, in fact, the claimed product can be made by the alleged process, the Office has failed to show that the alleged process is materially different from the claimed process. Accordingly, Applicants respectfully submit that the Restriction Requirement is unsustainable, and it should therefore be withdrawn.

The Office has characterized the inventions of Groups I and (III-VII); Groups II and (III-VII); and Groups III-VII as unrelated. Citing MPEP §806.04 and MPEP §808.01, the Office merely states these conclusions and asserted distinctions. However, the Office has not provided sufficient reasons and/or examples to support this assertion. Accordingly, the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Accordingly, Applicants respectfully submit that the Restriction Requirement should be withdrawn.

Applicants respectfully traverse on the additional grounds that the Office has not shown that a burden exists in searching the entire application.

Further, MPEP §803 states as follows:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on its merits, even though it includes claims to distinct or independent inventions.

Applicants submit that a search of all claims would not constitute a serious burden on the Office.

Additionally, MPEP §821.04 states:

...if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Applicants respectfully submit that should the elected group be found allowable, non-elected process claims should be rejoined.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Norman F. Oblon
Attorney of Record
Registration No. 24,618

Vincent K. Shier, Ph.D.
Registration No. 50,552

Customer Number

22850

Tel: (703) 413-3000

Fax: (703) 413-2220

(OSMMN 08/03)

NFO:VKS